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Westerman, Hattori, Daniels & Adrian, LLP
1250 Connecticut Avenue, N.W.
Suite 700
Washington, DC 20036

EXAMINER	
LAROSE, COLIN M	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/811,526
Filing Date: March 20, 2001
Appellant(s): CHIKAZAWA ET AL.

Joseph L. Felber
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/27/05 appealing from the Office action mailed 1/25/05.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUNDS OF REJECTION

The grounds of rejection advanced by the previous Examiner have been withdrawn in order to simplify the issues for appeal.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,940,526	SETLAK ET AL	8-1999
6,208,264	BRADNEY ET AL	3-2001

6,382,416 GAINEY 5-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

1. The following sections of 37 CFR §1.75(a) and (d)(1) are the basis of the following objection:

> (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
>
> (d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

2. Claims 5 and 15 are objected to under 37 CFR §1.75(a) and (d)(1) as failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

Regarding claim 5, there is insufficient antecedent basis for "the recess."

Regarding claim 15, there is insufficient antecedent basis for "the unit casing."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,940,526 by Setlak et al. ("Setlak").

Regarding claims 1, 7, and 13, Setlak discloses a fingerprint recognizing apparatus (figure 4, and corresponding elements of figure 2) comprising:

a sensor section (52 & 78, figure 2) mounted on the apparatus body for detecting a fingerprint of an operator (sensor section comprises placement surface 52, on which a finger is placed, and sensing electrode 78, which is connected to sensing electronics – see figure 2, col. 4/46-51, and col. 5/21-25);

a cover (53', figure 4) movable between an open position and a closed position for protecting the sensor section in such a manner that an operator's finger can access the sensor section when the cover is in the open position (i.e. the cover 53' is disposed over the package 51, as shown in figure 4 and described at col. 6/38-47; figure 2 shows that the package 51 includes the placement surface 52 – since the cover 53' covers the package 51, it also covers the placement surface 52; when the operator opens the cover, his finger can access the sensor section in order to place his finger on the placement surface 52); and

a contact section (54, figures 2 and 4) arranged on the apparatus body at a position where the operator's finger can easily come into contact therewith during an operator's action to open the cover, the contact section being electrically connected to the ground of the apparatus body (i.e. when the operator performs an action to open the cover 53' and thereby place his finger on the placement surface 52, his finger comes into contact with the contact section 54, as shown in

figure 2; the contact section 54 acts as a power control means for powering the fingerprint apparatus from a sleeping state upon detection of a finger, and the contact section 54 is electrically connected to grounded -- see col. 6/13-18 & 6/48-58),

wherein the contact section is a separate element from the cover (i.e. the contact section 54 and the cover 53' are different elements, as shown in figure 4).

Further regarding claims 7 and 13, Setlak's fingerprint apparatus is mounted on the package 51, which serves as a unit casing.

Further regarding claim 13, Setlak discloses a ground plate 54 which is rigidly connected to the unit casing (i.e. contact section 54 doubles as a contact plate that is grounded – col. 6/48-58), the contact section is formed as a part of the ground plate (i.e. the ground plate encompasses the contact section).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2-5, 8-10, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,940,526 by Setlak et al. ("Setlak") in view of U.S. Patent 6,208,264 by Bradney et al. ("Bradney").

Regarding claims 2 and 8, Setlak discloses that the cover 53' is "pivotally connected" (col. 6/43-44), however, Setlak does not expressly disclose that the cover 53' "has one free end and another base end and is moved ... by means of a hinge," as claimed.

Bradney discloses a fingerprint sensing apparatus (figure 4a) that utilizes a cover pivotally connected cover disposed over the sensing portions in substantially the same manner as Setlak. Bradney's figure 4a shows the cover being pivotally connected by means of a hinge so that the cover has one free end and another base end that pivots. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a hinge as taught by Bradney, since Bradney shows that utilizing a hinge is a conventional way to "pivotally connect" a fingerprint sensor cover.

Regarding claim 3, this claim includes substantially all of the limitations of claim 2, which as shown above, is an obvious variant of Setlak and Bradney. Claim 3 further recites, "the contact section is arranged in a recess which is provided on the apparatus body near to the free end of the cover when it is in the closed position."

Figure 4a of Bradney illustrates a fingerprint sensor apparatus design where the contact section 58+64 is arranged in a recess near the free end of the cover when the cover is in the closed position. Such a design would have been obvious to those skilled in the art at least for the ergonomic benefits of comfortably receiving a user's finger in a recessed portion. Bradney shows this design of a fingerprint apparatus to be conventional and well-known.

Regarding claim 4, this claim includes substantially all of the limitations of claim 2, which as shown above, is an obvious variant of Setlak and Bradney. Claim 4 further recites, "the

free end of the cover is gently curved in such a manner that a central portion thereof is protruded outwardly more than respective side portions thereof."

Figure 4a of Bradney illustrates a fingerprint sensor apparatus design where the free end of the cover is curved in such a manner, apparently to reciprocate the recess of the contact surface. Such a design would have been obvious to those skilled in the art at least for the purpose of fitting the cover within a recessed contact surface portion. Bradney shows this design of a cover for a fingerprint apparatus to be conventional and well-known.

Regarding claim 5, the combination of Setlak and Bradney teach a fingerprint sensor having the protrusion of the cover corresponding to curved recess of the contact section, as shown in figure 4a of Bradney.

Regarding claim 9, this claim includes substantially all of the limitations of claim 8, which as shown above, is an obvious variant of Setlak and Bradney. The claim further recites, "the contact section is arranged in a recess which is provided on the unit casing near to the free end of the cover when it is in the closed position."

Figure 4a of Bradney illustrates a fingerprint sensor apparatus design where the contact section 58+64 is arranged in a recess near the free end of the cover when the cover is in the closed position. Such a design would have been obvious to those skilled in the art at least for the ergonomic benefits of comfortably receiving a user's finger in a recessed portion. Bradney shows this design of a fingerprint apparatus to be conventional and well-known.

Regarding claim 10, Setlak appears to be silent to "the free end of the cover is gently curved in such a manner that a central portion thereof is protruded outwardly more than respective side portions thereof."

Figure 4a of Bradney illustrates a fingerprint sensor apparatus design where the free end of the cover is curved in such a manner, apparently to reciprocate the recess of the contact surface. Such a design would have been obvious to those skilled in the art at least for the purpose of fitting the cover within a recessed contact surface portion. Bradney shows this design of a cover for a fingerprint apparatus to be conventional and well-known.

Regarding claim 15, Setlak discloses an information processing unit (figures 2 and 4) including a fingerprint recognizing apparatus, said unit comprising:

a unit body (51) comprising a data input section (placement surface 52 for inputting finger data) and a data processing section (sensing electrode 78, which is connected to sensing electronics) for processing data input from the data input section;

the fingerprint recognizing apparatus mounted on the unit casing for detecting a fingerprint of an operator, the apparatus comprising:

a sensor section (i.e. placement surface 52 coupled with sensing electrode 78);

a cover (53', figure 4) movable between an open position and a closed position for protecting the sensor section; and

a contact section (54, figures 2 and 4) arranged on the apparatus body at a position where the operator's finger can easily come into contact therewith during an operator's action to open the cover, the contact section being electrically connected to the ground of the apparatus body

(i.e. when the operator performs an action to open the cover 53' and thereby place his finger on the placement surface 52, his finger comes into contact with the contact section 54, as shown in figure 2; the contact section 54 acts as a power control means for powering the fingerprint apparatus from a sleeping state upon detection of a finger, and the contact section 54 is electrically connected to grounded -- see col. 6/13-18 & 6/48-58),

wherein the contact section is a separate element from the cover (i.e. the contact section 54 and the cover 53' are different elements, as shown in figure 4).

Setlak does not expressly disclose a display section for displaying letters and images, as claimed.

Bradney discloses including a display (26) within an information processing unit (see figure 2). The display is included because Bradney's fingerprint recognizing apparatus is utilized in a financial transaction environment where a customer views information on a screen. Such inclusion of a display for displaying letter and images would have been obvious to those skilled in the art in view of Bradney's teaching that, when a fingerprint recognizing apparatus is utilized in a financial transaction setting, it is conventional to provide a display whereby customers and/or operators can view details of the transaction.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Setlak.

Regarding claim 14, The Examiner takes Official Notice that, at the time of the applicant's claimed invention, the usage of mounting plates to mount electronic devices to casings or enclosures via a screw(s) was well known. Mounting plates have the advantage that the pressure(s) of the screw(s) is distributed over the area encompassed by the plate. Among

other things, this stabilizes the mounted component, allows the mounted component to be flush with the mounting surface of the casing, and provides more uniform pressure to the surface of the mounted compone0nt, thereby reducing potential damage (e.g. cracking) of the component when pressure is applied during the mounting process.

It would have been straightforward for one of ordinary skill in the art to attach the fingerprint recognition apparatus to the unit casing by using a mounting plate secured by screws. Given the ease with which this can be done and the advantage of using such plates, it would have been obvious to one of ordinary skill in the art, at the time of the applicant's claimed invention, to secure the fingerprint recognition apparatus to the unit casing using mounting plate fixed in place by means of screws. In doing so, one obtains an electrical unit, in accordance with claim 7, further comprising a mounting plate for rigidly securing the fingerprint recognizing apparatus to the unit casing by means of screws. Such an electrical unit satisfies all limitations of claim 14.

8. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setlak in view of 6,382,416 by Gainey.

Reagrding claims 6 and 12, Setlak does not explicitly include a locking means for locking the cover 53' in its closed position, the locking means comprising:

a. a first engaging member provided at the free end of the cover, and
b. second engaging member provided at a position corresponding to the first engaging member so that the first and second engaging member are mutually engaged with each other when the cover is in its closed position.

Gainey discloses fingerprint recognition apparatus (e.g. Gainey Figs. 3Cand 4A) consisting of a locking means (i.e. looped latch lock 34 and the engaging portion of cover 32 depicted in Fig.3C of Gainey – see also column 2, lines 34-38 and column 5, lines 38-55) used to lock, in a closed position, a movable hinged cover (e.g. Gainey Fig. 3C reference number 32), which protects the fingerprint recognition sensor (e.g. Gainey Fig. 4A, reference number 28). See, for example, Fig. 3C of Gainey and column 5, lines 38-55. This locking means includes of the following elements:

a. A first engaging member provided at the free end of the cover. Observe, in Fig. 3C of Gainey, the lip at the end or cover 32 opposite to hinge 36 (i.e. the free end). This lip engages the latch lock 34 and thus, for the purposes of this discussion, constitutes a *first* engaging member.

b. Second engaging member provided at a position corresponding to the first engaging member so that the first and second engaging member are mutually engaged with each other when the cover is in its closed position. This is evident from the operation of the latch lock 34 illustrated in Fig. 3C of Gainey and further described in column 5, lines 38-55. This latch lock, since it mutually engages the first engaging member, constitutes a *second* engaging member.

It would be a simple exercise for one of ordinary skill in the art to incorporate the locking means taught by Gainey into the fingerprint recognition apparatus of Setalk. The addition of the locking means secures the cover in the closed position more firmly, thereby further protecting the delicate sensor from inadvertent exposure to potentially harmful entities or forces. Given the simplicity of such a modification and motivated to provide a more robust fingerprint recognition

apparatus, it would have been obvious to one of ordinary skill in the art, at the time of the applicant's claimed invention, to incorporate the locking means taught by Gainey into the fingerprint recognition apparatus of Setlak.

(10) Response to Argument

Appellant's arguments have been considered but are now moot in view of the new grounds of rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any

amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Colin LaRose

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Leo Boudreau, TC 2600

Conferees:

Joe Mancuso

Jingge Wu

Leo Boudreau
Acting Director